



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/389,557	09/03/99	SANO	7217/59652

JAY H MAIOLI
COOPER & DUNHAM LLP
1185 AVENUE OF THE AMERICAS
NEW YORK NY 10036

WM02/0625

EXAMINER

BRIER, J

ART UNIT	PAPER NUMBER
----------	--------------

2672

DATE MAILED: 06/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/389,557

Applicant(s)

SANO ET AL.

Examiner

Jeffery A. Brier

Art Unit

2672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The preliminary amendment filed on 1/12/2001 has been entered.

Drawings

2. The drawings have been approved by the draftsman.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 7, 8, 15, and 16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants specification fails to convey that applicant had possession of claim 7 as amended. Claim 7 claims "wherein the control of said equipment is controlled by of a cursor". The originally filed specification did not convey that applicant's cursor controlled equipment.

Art Unit: 2672

Applicants specification fails to convey that applicant had possession of claim 8 as amended. Claim 8 claims "wherein the control of said equipment is controlled by a pointer". The originally filed specification did not convey that applicant's pointer controlled equipment. Applicants specification fails to convey that applicant had possession of claim 15 as amended. Claim 15 claims "wherein control of said video equipment includes controlling using a cursor". The originally filed specification did not convey that applicant's cursor controlled video equipment. Applicants specification fails to convey that applicant had possession of claim 16 as amended. Claim 16 claims "wherein control of said video equipment includes controlling using a pointer". The originally filed specification did not convey that applicant's pointer controlled video equipment. Page 11 lines 13-14 has been considered but the mere mention of a menu does not convey that applicant had possession of using a cursor or pointer to control equipment.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 2, 7/2, 8/2, 4-6, 7/3, 7/5, 8/3, 8/5, 9, 10, 15/10, 16/10, and 12-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 7/3, 7/5, 8/3, and 8/5 are indefinite because "The control apparatus" at line 1 in each of these claims lacks antecedent basis in the claims. Claims 7/3, 7/5, 8/3, and 8/5 are additionally indefinite because "said equipment" in

Art Unit: 2672

each of these claims lacks antecedent basis in the claims. Claims 15/10 and 16/10 are indefinite because "said video equipment" in each of these claims lacks antecedent basis in the claims. Claims 1, 4, 9, and 12 are indefinite because the phrase and/or is indefinite. The phrase "means for judging similarity and/or non-similarity of each action made by said plurality of command means" is indefinite. It is not clear how each action is both similar and non-similar and it is not clear what each action is being compared with.

Claim Objections

8. Claim 7 is objected to because of the following informalities: At line 4 "by of" should be changed to "by". Appropriate correction is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 3, 5/3, 6/5, 6/3, 11, 13/11, 14/13, and 14/11 are rejected under 35 U.S.C. 102(b) as being anticipated by Canfield et al., U.S. Patent No. 5,091,785. Canfield teaches video equipment and the method of controlling video equipment which arbitrarily places a second image onto a first image (picture-in-picture) in response to user commands from a remote controller shown in figure 2. The group of buttons

Art Unit: 2672

labeled 210 in figure 2 allows the user to move the second image to different positions on the first image. The group of buttons 210 is the claimed plurality of command means. At column 3 lines 31-44 Canfield describes moving the second image to any location on the display.

Re claims 5/3 and 13/11:

Canfield's figure 3 shows the display position of the second image outside the effective area of the first image. In other words the second image is on the boundary of the display. Also the second image may be moved by the user to a location outside the effective area of the first image or outside the user's area of interest in the first image.

Re claims 6/5, 6/3, 14/13, and 14/11:

Canfield writes the PIP addresses into PIP unit 150, column 3 lines 49-50. Thus Canfield stores the location of the second image in memory.

11. Claims 1, 2, 7/2, 8/2, 9, 10, 15/10, and 16/10 are rejected under 35 U.S.C. 102(b) as being anticipated by Sombroek et al., EP 0 631 223 A1. Claim 1 claims a control apparatus having a plurality of command means and controlling equipment according to actions made by said plurality of command means and claim 9 claims a control method using a plurality of command means and controlling equipment according to each action made by said plurality of command means. Claims 1 and 9 further claim: (1) a means or step for judging the means for judging similarity and/or non-similarity of each action

Art Unit: 2672

made by said plurality of command means; (2) a means or step for determining the response time for each of actions made by the plurality of command means; and (3) when the displayed position of the second image controlled according to an action made by each of the command means alternatively and when similarity is judged the response time is modified. Sombroek describes on column 4 lines 6-9 a joystick used as a user interface tool. At column 4 lines 36-49 describes how the cursor is moved at one speed for a first time period and then accelerates to a second speed after the first time period has elapsed. The joystick corresponds to the claimed plurality of command means because the joystick supplies at least four signals indicative of x, -x, y, and -y movement commands. Note figure 4 and pressure sensitive resistors 402-408. Thus, movement of the user interface, indicative of x, -x, y, and -y, is judged by 304 and 306 as being similar types of input causing the speed of the cursor to increase as the command means 402-408 in aggregation continuously produces an output within a first time period.

Re claims 7/2 and 15/10:

Claims 7/2 and 15/10 are assumed to mean control of a cursor. Sombroek controls the movement of a cursor, note the abstract and the field of the invention.

Re claims 8/2 and 16/10:

Claims 8/2 and 16/10 are also assumed to mean control of a pointer. A pointer by definition is the same as a cursor. Note the attached Microsoft Computer Dictionary

Art Unit: 2672

which defines pointer on page 348 by referring to mouse pointer on page 298 which makes reference to the definition of cursor on page 119. Also note the attached Dictionary of Computers, Information Processing, and Telecommunications which defines pointer on page 470 with a definition (2) similar to the definition given for cursor on page 139 definition (1). Thus, a cursor and a pointer are the same and the cursor of Sombroek is the same as the claimed pointer.

Re claims 7/2, 15/10, 8/2, and 16/10:

Also for claims 7/2, 15/10, 8/2, and 16/10 it should be noted that the cursor or pointer of Sombroek controls the Compact Disc Interactive described at column 1 lines 14-47 by a cursor described at column 1 lines 37-41. Compact Disc Interactive is video equipment. Thus, Sombroek teaches controlling video equipment with a cursor or pointer.

12. Claims 3, 4, 5, 7/3, 7/5, 8/3, 8/5, 11, 12, 13, 15/11, 15/13, 16/11, and 16/13 are rejected under 35 U.S.C. 102(b) as being anticipated by Sombroek et al., EP 0 631 223 A1. Claims 3 and 11 claim video equipment and controlling video equipment. The Compact Disc Interactive described at column 1 lines 14-47 is video equipment and the video equipment is controlled by a cursor described at column 1 lines 37-41. The claimed second image is the cursor which is controlled by a joystick. The joystick corresponds to the claimed plurality of command means for the reasons given above for claims 1 and 9.

Art Unit: 2672

Re claims 4 and 12:

Claims 4 and 12 add to their parent claims: (1) a means or step for judging the "means for judging similarity and/or non-similarity of each action made by said plurality of command means"; (2) a means or step for determining the response time for each of actions made by the plurality of command means; and (3) when the displayed position of the second image controlled according to an action made by each of the command means alternatively and when similarity is judged the response time is modified. These are the same limitations that are present in claims 1 and 9. Note the above discussion of Sombroek for claims 1 and 9.

Re claims 5 and 13:

The cursor of Sombroek may be set outside of the effective area by the user.

Re claims 7/3 7/5, 15/11, and 15/13:

Claims 7/3, 7/5, 15/11 and 15/13 are assumed to mean control of a cursor. Sombroek controls the movement of a cursor, note the abstract and the field of the invention.

Re claims 8/3, 8/5, 16/11, and 16/13:

Claims 8/3, 8/5, 16/11, and 16/13 are also assumed to mean control of a pointer. A pointer by definition is the same as a cursor. Note the attached Microsoft Computer Dictionary which defines pointer on page 348 by referring to mouse pointer on page 298

Art Unit: 2672

which makes reference to the definition of cursor on page 119. Also note the attached Dictionary of Computers, Information Processing, and Telecommunications which defines pointer on page 470 with a definition (2) similar to the definition given for cursor on page 139 definition (1). Thus, a cursor and a pointer are the same and the cursor of Sombroek is the same as the claimed pointer.

Re claims 7/3 7/5, 8/3, 8/5, 15/11, 15/13, 16/11, and 16/13:

Also for claims 7/3 7/5, 8/3, 8/5, 15/11, 15/13, 16/11, and 16/13 it should be noted that the cursor or pointer of Sombroek controls the Compact Disc Interactive described at column 1 lines 14-47 by a cursor described at column 1 lines 37-41. Compact Disc Interactive is video equipment. Thus, Sombroek teaches controlling video equipment with a cursor or pointer.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Canfield et al., U.S. Patent No. 5,091,785 as applied to claims 3 and 11 above and further in view of Sombroek et al., EP 0 631 223 A1 as applied to claims 1 and 9 above.

Art Unit: 2672

Canfield teaches video equipment and the method of controlling video equipment which arbitrarily places a second image onto a first image (picture-in-picture) in response to user commands from a remote controller shown in figure 2. The group of buttons labeled 210 in figure 2 allows the user to move the second image to different positions on the first image. The group of buttons 210 is the claimed plurality of command means. Column 3 lines 31-44 Canfield describes moving the second image to any location on the display.

Claims 4 and 12 add to their parent claims: (1) a means or step for judging the "means for judging similarity and/or non-similarity of each action made by said plurality of command means"; (2) a means or step for determining the response time for each of actions made by the plurality of command means; and (3) when the displayed position of the second image controlled according to an action made by each of the command means alternatively and when similarity is judged the response time is modified. These three additional limitations to parent claims 3 and 11 is not taught by Canfield. These limitations are substantially the limitations found in independent claims 1 and 9.

However, Canfield does suggest at column 3 lines 55-61 different rates of movement by acknowledging the VRAM must be read out once during each field "regardless of the desired rate of panning or scrolling".

Sombroek describes on column 4 lines 6-9 a joystick used as a user interface tool. At column 4 lines 36-49 describes how the cursor is moved at one speed for a first time period and then accelerates to a second speed after the first time period has

Art Unit: 2672

elapsed. The joystick corresponds to the claimed plurality of command means because the joystick supplies at four signals indicative of x, -x, y, and -y movement commands. Note figure 4 and pressure sensitive resistors 402-408. Thus, movement of the user interface indicative of x, -x, y, and -y is judged by 304 and 306 as being similar types of input causing the speed of the cursor to increase as the command means 402-408 in aggregation continuously produces an output within a first time period.

It would have been obvious to one of ordinary skill in the art at the time of applicants invention to modify the response time of a command's corresponding action (movement of second image) because Canfield suggests different rates of movement in response to a command and because Sombroek teaches that it is desirable to modify the response time of a command's corresponding action (second image movement) to assist the user in moving the second image with the command means (user interface/joystick).

Conclusion

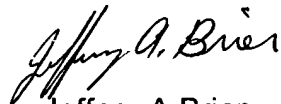
15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The IBM Technical Disclosure Bulletin titled Cursor Movement Control Circuitry, teaches moving a second image (cursor) at a greater rate when the user continues if the joystick is held in an operative position.

Art Unit: 2672

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is (703) 305-4723. The examiner can normally be reached on M-F from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached on (703) 305-4713. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.



Jeffery A Brier
Primary Examiner
Art Unit 2672